



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,286	12/20/2001	Matthew J. Dejneka	SP01-371	1375
22928	7590	12/10/2004	EXAMINER	
CORNING INCORPORATED			DO, PENSEE T	
SP-TI-3-1			ART UNIT	
CORNING, NY 14831			PAPER NUMBER	

1641

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/027,286	Applicant(s) DEJNEKA ET AL.	
	Examiner Pensee T. Do	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 26-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-57 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/23/03 &amp; 12/20/01</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of group I, claims 1-25 in the reply filed on September 23, 2004 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 6-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 23 are indefinite for reciting abbreviations such as "Ce, Pr, Nd, Sm etc.." for abbreviations may have more than one meaning.

Claim 3 is indefinite for reciting "adapted to" because it is unclear of how the label is modified in order to be adapted to detect an analyte.

Claim 6 is vague. It is unclear as to how the particle "includes" a cross-section of a fiber or an array of layers.

Claim 19, "the layers" lack antecedent support. There has been no mention about "the layers" in the previous claims, i.e. claim 3, 17, 18.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1641

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4 are rejected under 35 U.S.C. 102(b) as being anticipated by

Oyobe et al. (US 5,262,365).

Oyobe teaches a doped silica glass containing a rare earth element such as Erbium or Neodymium. An optical fiber or optical waveguide having a core-clad structure can be easily prepared by using rare-earth element doped silica glass for the core and glass having a refractive index lower than that of the former such as F-doped silica for the clad. (see col. 5, lines 32-38; lines 66-68; col. 6, lines 53-68). Regarding the limitation of claim 4, since it is drawn to the use of the label, it is not given any patentable weight because whatever the use of the label is, the components or contents of the label does not alter.

Claims 1-4, 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by

Kardos et al. (US 6,159,686).

Kardos teaches a label comprising of phosphor particles derived from phosphor host materials, each doped with at least one activator couple. Suitable host materials are sodium yttrium fluoride, lanthanum fluoride; etc... Suitable activator couples are ytterbium/erbium, ytterbium/thulium; and ytterbium/holmium. By combination of host materials with activator couples, at least three phosphors with at least three different emission spectra are provided. Generally, the absorber is ytterbium and the emitting

Art Unit: 1641

center can be selected from erbium, holmium, terbium, and thulium. (see col. 14, lines 15-63). Regarding the limitation of claim 4, since it is drawn to the usage of the label, it is not given any patentability weight. The phosphor particles can be coated with a polycarboxylic acid and various proteins (immunoglobulin, streptavidin, or protein) can be physically adsorbed to the surface of the phosphor particles. Probes such as proteins or polynucleotides may be directly attached to the phosphor by covalent linkage. (see col. 13, lines 13-30).

#### ***Remarks***

Claims 5-15, 19-25 are free of prior arts.

#### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 703-308-4398. The examiner can normally be reached on Monday-Friday, 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1641

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pensee T. Do  
Patent Examiner  
December 4, 2004

  
CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800/1641  
12/8/04